

REMARKS/ARGUMENTS

Drawings

The Examiner objected to the drawings because the limitations “said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed member attached to said vertically disposed member” as claimed in claim 79 must be shown or the feature(s) cancelled from the claim(s).

RESPONSE

In response, Applicant respectfully refers to Figure 7a which depicts both the vertically disposed members and horizontally disposed members mentioned in claim 79. As a result, Applicant has not modified the drawings in response to this objection.

Claim Rejections – 35 U.S.C. §112

The Examiner rejected claims 79-91 because the specification does not provide support of the limitations as claimed in claims 79-91. Specifically, nowhere in the specification discloses the limitations “said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed member attached to said vertically disposed member.”

RESPONSE

In response, Applicant respectfully refers to Figure 7a which depicts both the vertically disposed members and horizontally disposed members mentioned in claim 79. As a result, Applicant has not amended claims 79-91 in response to this rejection.

Claim Rejections – 35 U.S.C. §112

The Examiner rejected claims 8, 16-19, 26-32, 34, 46-49, 53-56, 66, 68-70, 81-84, and 87-92 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

RESPONSE

In response to the Examiner's rejection of claim 8, Applicant, acting as its own lexicographer, has identified the element "a rear vertical surface" in order to distinguish from the front and rear vertical surfaces of the auxiliary clip-on assembly and in order to identify the location for affixation of the end piece retainers as mentioned in claim 16. As a result, Applicant has not amended claim 8 in response to this rejection.

In response to the Examiner's rejections of claims 16-19, 26-32, 34, 46-49, 53-56, 66, 68-70, 81-84, and 87-92. Claims 16-19, 26-32, 34, 46-49, 53-56, 66, 68-70, 81-84, and 87-92 have been amended according.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. §102(b) as being anticipated by Xiao (6,505,932). According to the Examiner, the limitations in claims 1, 2, and 5 are shown in Xiao's Fig. 1, columns 3-4. According to the Examiner, Xiao discloses a primary spectacle frame assembly comprising: an eyerim 151; a first end piece 13 and a second end piece 14 attached to and extending from a first outer side and a second outer side of said eyerim; a first rimblock 17 and a second rimblock 18, a bridge 111 attached to and connecting the inner sides of said eyerim; a first temple 112; and a second temple 113.

RESPONSE

In response, first, the basic principle of this invention is the non-magnetic, flexible auxiliary clip-on which is tension mounted to a mating spectacle frame. The auxiliary clip-on only works as a complete assembly. It does not matter if it is a one piece lens, is construction of metal, or is constructed of plastic. The flexibility of the total assembly is what holds the auxiliary clip-on on the primary spectacle frame. Without that, the retainers would just fall off. The retainers are only able to grip the outside edges of the frame when the curvature of the clip-on assembly is allowed to return to normal width.

Second, an important part of the invention is that the shape and size of the auxiliary clip-on assembly does not limit the invention other than the fact that it should be the same width or larger than the width of the primary spectacle frame. This fact makes it uniquely possible to create an auxiliary clip-on assembly that has a sunglass shape to fit on a primary spectacle frame that is a more conservative prescription shape.

Third, the invention makes it possible to fit the auxiliary clip-on assembly to a usual and customary primary spectacle frame without the necessary addition of any parts, holes, magnets, pins or any other non-standard modification. Thus, when the primary spectacle frame is worn without the auxiliary clip-on assembly in place, there is absolutely no indication anywhere that it accommodates an auxiliary clip-on assembly.

With respect to Xiao specifically, Xiao relates to a primary spectacle frame equipped with frame lockers made of magnetic attractable material. The Xiao primary spectacle frame must be equipped with special components, such as the frame lockers, for attachment with the auxiliary frame. The Xiao primary and auxiliary spectacle frames rely on magnetic attraction for engagement. On the other hand, the present invention specifically relates to non-magnetic

primary and auxiliary frames. The primary frame is not equipped with any special features, such as frame lockers, to engage with the auxiliary clip-on assembly. The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Xiao.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 8-13, 20, 23, 26, 27, 30, and 32 under 35 U.S.C. §102(b) as being anticipated by Martin (5,867,244). According to the Examiner, the limitations in claims 8-13, 20, 23, 26, 27, 30, and 32 are shown in Martin's Figs. 1-2, columns 2-3. According to the Examiner, Martin discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses; a rear vertical surface; and a first and second end piece retainers 40, 42.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention.

With respect to Martin specifically, Martin relies on clips to grasp the eyerims or bridge. The Martin device relies on a total of three clips in order to function and can only be functional when the primary frame has a small enough bridge. The Martin device will not function if the bridge of the primary spectacle frame is at the level of the top rims (higher than the two outer clips) as in the case of many contemporary frames. If that is the case, the clip will just fall off and the primary and auxiliary will not be engaged. In addition, the Martin clips further require a perfect match. The Martin invention is further limited to metal frames. On the other hand, with

respect to the present invention, the present invention does not rely on outdated means such as clips to secure the primary and auxiliary frames.

Further, Martin is contradictory. The patent both indicates engagement “without the need for tensioning” and yet references a “third tensioning clip.”

The present invention is clearly distinguished from Martin.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 8, 15, and 16 under 35 U.S.C. §102(b) as being anticipated by Sadler (5,416,537). According to the Examiner, the limitations in claims 8, 15, and 16 are shown in Sadler’s Figs. 1-3, columns 2-3. According to the Examiner, Sadler discloses an auxiliary clip-on assembly comprising: a plurality of clip-on lenses 11, a rear vertical surface; and a first and second end piece retainers 17.

RESPONSE

In response, the Applicant hereby incorporates the Applicant’s preliminary statements regarding the present invention. With respect to Sadler, Sadler utilizes magnets on both the primary and auxiliary frames for engagement. On the other hand, the present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as magnetic members, to engage with the auxiliary clip-on assembly. The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Sadler.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 33-40 and 43-65 under 35 U.S.C. §102(b) as being anticipated by Lee (2001/0021001). According to the Examiner, the limitations in claims 33-40 and 43-65 are shown in Lee's Figs. 1, 2, and 6-8, pages 2-3. According to the Examiner, Lee discloses an eyeglass device comprising: a primary spectacle frame assembly 100 for supporting primary lenses 101 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Lee, Lee utilizes magnets on both the primary and auxiliary frames for engagement. On the other hand, the present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as magnets, to engage with the auxiliary clip-on assembly. The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Lee.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 33, 34, 41, and 42 under 35 U.S.C. §102(b) as being anticipated by Huang (6,113,234). According to the Examiner, the limitations in claims 33, 34, 41, and 42 are shown in Huang's Figs. 1, 2, column 2. According to the Examiner, Huang

discloses an eyeglass device comprising: a primary spectacle frame assembly 10 for supporting primary lenses 23 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple 11 thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions. Further, according to the Examiner, regarding claims 41 and 42, the frame in the auxiliary frame inherently includes a torsion bar.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Huang, the auxiliary frame is described as a one cast piece which is very limiting. Further, Huang embodies "hooks" to fit into the recessed notches in the primary frame. Moreover, due to the attachment requirements, the Huang invention will not work in the case of round wire type temples which are about one millimeter in diameter. In the Huang invention, repeated attachment and detachment will mar and/or scratch the sides of the primary spectacle frame where the hooks slide against it to fit into the notches. The Huang invention is further limited due to the fact that the Huang invention does not allow for an auxiliary frame that is larger in width than the primary frame width.

On the other hand, the present invention requires no modification of the usual and customary primary frame – such as the presence of recessed notches in the primary frame of Huang. Further, the end piece retainers of the auxiliary frame will not damage the primary frame unlike the Huang invention. The primary frame of the present invention can accommodate auxiliary frames which are larger than the primary frame. The present invention is clearly distinguished from Huang.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claim 71 under 35 U.S.C. §102(b) as being anticipated by Lemelson (4,217,037). According to the Examiner, the limitations in claim 71 are shown in Lemelson's Figs. 1-6, columns 2-4. According to the Examiner, Lemelson discloses an auxiliary clip-on assembly comprising: a single member lens 41 possessing a front vertical surface and a rear vertical surface; a plurality of end piece retainers 44; and a plurality of fasteners wherein said plurality of end piece retainers 44 are mounted on said rear surface of said single member lens and said fasteners are mounted on said front surface of said single member lens and wherein said fasteners couple said end piece retainers to said lens by penetrating said lens.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Lemelson, the retaining means for the eye protection unit of Lemelson, the L-shaped fittings 27, 37, and 44, do not resemble the end piece retainers 10 of the auxiliary clip-on assembly which grip the primary spectacle frame of the present invention. As the end piece retainers attach the primary spectacle frame from the top and bottom and the eyerims or end pieces, rather than merely resting on the top of the primary spectacle frame as in Lemelson. This differing attachment device, the end piece retainers, and corresponding differing attaching means clearly distinguishes the present invention from Lemelson.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claim 3 79-91 under 35 U.S.C. §102(e) as being anticipated by Ifergan (6,811,254). According to the Examiner, the limitations in claims 79-91 are shown in Ifergan's Figs. 1-22, columns 2-6. According to the Examiner, Ifergan discloses an auxiliary clip-on assembly comprising: an auxiliary frame for housing a pair of lenses; a first and a second end piece retainer, said first and second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Ifergan, Ifergan relies on magnetic members for the engagement of the primary and auxiliary frames. In contrast, the auxiliary clip-on assembly of the present invention is not equipped with magnetic members – rather, the auxiliary clip-on assembly is equipped with end piece retainers for secure attachment to the primary spectacle frame. The present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as magnets, to engage with the auxiliary clip-on assembly. The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Ifergan.

Applicant notes that this rejection based on Ifergan included the patent number for Parker rather than Ifergan; however, the text that followed only referred to Ifergan. As a result, Applicant has not addressed Parker at this time.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 92 and 93 under 35 U.S.C. §102(b) as being anticipated by Xiao. According to the Examiner, the limitations in claims 92 and 93 are shown in Xiao's Figs. 1-3, columns 3-4. According to the Examiner, Xiao discloses an eyeglass device comprising: a primary frame 10 for supporting primary lenses 121, 122 therein; the primary frame including two side portions 13, 14, a front portion and a rear portion; and the primary frame including a first and a second rimblock 17, 18 respectively having a horizontal surface and being secured to one of said side portions of said primary spectacle frame; and an auxiliary frame 20 for supporting auxiliary lenses 201, 202 therein and for disposing in front of the primary spectacle frame 10, the auxiliary spectacle frame 20 including an auxiliary rear portion, wherein the auxiliary spectacle frame further includes two end piece retainers 22, 23 each secured to said auxiliary rear portions and having a horizontal surface for coupling a corresponding horizontal surface of one of said rimblocks so as to secure the auxiliary frame to the primary frame.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Xiao specifically, Xiao relates to a primary spectacle frame equipped with frame lockers made of magnetic attractable material. The Xiao primary spectacle frame must be equipped with special components, such as the frame lockers, for attachment with the auxiliary frame. The Xiao primary and auxiliary spectacle frames rely on magnetic attraction for engagement. On the other hand, the present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as frame lockers, to engage with the auxiliary clip-on assembly. The

primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Xiao.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claims 3, 4, 6, and 7 under 35 U.S.C. 103(a) as being unpatentable over Xiao. According to the Examiner, regarding claims 3 and 4 since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Further, according to the Examiner, regarding claims 6 and 7, the optical properties of the lenses in a pair of spectacle depend on the needs of the user such as prescription lenses or sunglass lenses which are well known and commonly used in this art. Therefore, according to the Examiner, the limitations in claims 6 and 7 are unpatentable over Xiao reference.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Xiao specifically, Xiao relates to a primary spectacle frame equipped with frame lockers made of magnetic attractable material. The Xiao primary spectacle frame must be equipped with special components, such as the frame lockers, for attachment with the auxiliary frame. The Xiao primary and auxiliary spectacle frames rely on magnetic attraction for engagement. On the other hand, the present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as frame lockers, to engage with the auxiliary clip-on assembly. The

primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Xiao.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claims 14, 21, 22, 24, 25, 28, 29, and 31 under 35 U.S.C. 103(a) as being unpatentable over Martin. According to the Examiner, regarding claims 14, 24, and 25 since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Further, according to the Examiner, regarding claims 21 and 22, absence showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

Moreover, according to the Examiner, regarding claims 28, 29, and 31, although the Martin device does not teach the shape and size of the auxiliary clip-on assembly being difference from those of the primary spectacle frame as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Martin reference by forming an auxiliary clip-on assembly being different from the primary spectacle frame in shape and size. Such a modification would have no functional differences from the Marin reference.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Martin specifically, Martin relies on clips to grasp the eyerims or bridge. The Martin device relies on a total of three clips in order to function and can only be functional when the primary frame has a small enough bridge. The Martin device will not function if the bridge of the primary spectacle frame is at the level of the top rims (higher than the two outer clips) as in the case of many contemporary frames. If that is the case, the clip will just fall off and the primary and auxiliary will not be engaged. In addition, the Martin clips further require a perfect match. The Martin invention is further limited to metal frames. On the other hand, with respect to the present invention, the present invention does not rely on outdated means such as clips to secure the primary and auxiliary frames. Further, Martin is contradictory. The patent both indicates engagement "without the need for tensioning" and yet references a "third tensioning clip." The present invention is clearly distinguished from Martin.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claims 17-19 under 35 U.S.C. 103(a) as being unpatentable over Sadler. According to the Examiner, absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws of adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Sadler, Sadler utilizes magnets on both the

primary and auxiliary frames for engagement. On the other hand, the present invention specifically relates to non-magnetic primary and auxiliary frames. The primary frame is not equipped with any special features, such as magnetic members, to engage with the auxiliary clip-on assembly. The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is clearly distinguished from Sadler.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claims 66-70 under 35 U.S.C. 103(a) as being unpatentable over Huang. According to the Examiner, it should be noted that although claims 66-70 are “method claims,” the method steps consist of the broad steps of “attaching” and “applying,” and therefore these steps would be inherently satisfied by the apparatus of the reference.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Huang, the auxiliary frame is described as a one cast piece which is very limiting. Further, Huang embodies “hooks” to fit into the recessed notches in the primary frame. Moreover, due to the attachment requirements, the Huang invention will not work in the case of round wire type temples which are about one millimeter in diameter. In the Huang invention, repeated attachment and detachment will mar and/or scratch the sides of the primary spectacle frame where the hooks slide against it to fit into the notches. The Huang invention is further limited due to the fact that the Huang invention does not allow for an auxiliary frame that is larger in width than the primary frame width.

On the other hand, the present invention requires no modification of the usual and customary primary frame – such as the presence of recessed notches in the primary frame of Huang. Further, the end piece retainers of the auxiliary frame will not damage the primary frame unlike the Huang invention. The primary frame of the present invention can accommodate auxiliary frames which are larger than the primary frame. The present invention is clearly distinguished from Huang.

Claim Rejections – 35 U.S.C. §103

The Examiner rejected claim 78 under 35 U.S.C. 103(a) as being unpatentable over Lemelson. According to the Examiner, the optical properties of the lenses in a pair of spectacles depends on the needs of the user such as polarized lenses which are well known and commonly used in this art. Therefore, the limitations in claim 78 are unpatentable over the Lemelson reference.

RESPONSE

In response, the Applicant hereby incorporates the Applicant's preliminary statements regarding the present invention. With respect to Lemelson, the retaining means for the eye protection unit of Lemelson, the L-shaped fittings **27**, **37**, and **44**, do not resemble the end piece retainers **10** of the auxiliary clip-on assembly which grip the primary spectacle frame of the present invention. As the end piece retainers attach the primary spectacle frame from the top and bottom and the eyerims or end pieces, rather than merely resting on the top of the primary spectacle frame as in Lemelson. This differing attachment device, the end piece retainers, and corresponding differing attaching means clearly distinguishes the present invention from Lemelson.

Allowable Subject Matter

The Examiner has indicated that claims 72-77 would be allowable if re-written.

RESPONSE

In light of Applicant's responsive arguments with respect to the rejection of claim 71 based on Lemelson, Applicant has not re-written claims 72-77 at this time.

CONCLUSION

Reconsideration and further examination is respectfully requested.

A three month extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely. The Commissioner is hereby authorized to charge the amount of \$510 to Deposit Account No. 12-0115. Further, the Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 20-115.


Applicant has made a diligent effort to place the new claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Melissa Patangia, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

Appl. No. 10/769,238

Reply to Office action of January 19, 2005

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

7/19/05	
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